

### REMARKS

The courtesies extended by Examiner Anne Kubelik to Applicants, Vered Yesodi and Phyllis Posy, and their representative Rodney Fuller, during the interview on December 8, 2003 are noted and appreciated. The comments and amendments presented herein are substantially the same as those that were presented and discussed at the interview.

Claims 47, 49, 51, 62, 64, 65, 69, 71, 73, 74, and 78 are amended herein. Claims 47, 49, 51, and 55-79 are presently pending. The amended claims are supported by the specification and original claims so that their entry at this time is warranted. No new matter is being introduced. Specifically, the amendments to claims 47, 49, and 51 were made at the request of the Examiner for clarification purposes only, first to introduce early in the claim that the plants generated are male sterile and second that the plant is devoid of the polynucleotide sequence encoding recombinase. Claim 51, was also amended to correct a typographical error, which error would be obvious in view of the method steps of claim 51. Finally, claims 62, 64, 65, 69, 71, 73, 74, and 78 were amended to correct antecedent basis and claims 64 and 73 to further delete reference to a ribozyme RNA molecule.

During the interview, the Examiner acknowledged that claim 49 was basically allowable with minor amendments. We have made the requested amendments herein and thus respectfully request that claim 49 and the claims dependent thereon be allowed.

Our primary discussion during the interview was directed to the rejection of claim 47, and claims dependent thereon, under 35 U.S.C. §103(a) as being unpatentable in view of U.S. Patent No. 6,392,119 to Gutterson *et al.* (referred to hereafter as "Gutterson") for the reasons set forth in the June 2, 2003 Office Action.

As requested, we submit herewith, three 132 Declarations supporting the patentability of the invention and supporting the fact that the step of selecting progeny devoid of recombinase prior to the final step of crossing to obtain offspring characterized by exogenic allelism--step (c) of claim 47--is not obvious in view of Gutterson. The three 132 Declarations include one from Dr. Nir Ohad, Dr. Ezra Yagil, and Dr. Vered Yesodi.

Please note that both Dr. Ohad and Dr. Yagil have declared that they do not have a financial interest in Fertiseeds, Ltd. Both Dr. Ohad and Dr. Yagil further declare that they believe, as one skilled in the art having reviewed the present application and pending claims that the step of selecting progeny devoid of a polynucleotide sequence encoding a recombinase would not be an obvious step to one skilled in the art.

Dr. Yesodi's declaration further provides support of the fact that the invention as presently set forth in claim 47, specifically step (c), of selecting progeny devoid of a

recombinase gene prior to the step of crossing the devoid progeny with the second plant to obtain offspring characterized by stable exogenic allelism, is not obvious to one skilled in view of the Gutterson disclosure.

Dr. Yesodi's opinion is based on several facts. First, Gutterson does not teach or even suggest the active step of selecting "progeny devoid of the polynucleotide sequence encoding the recombinase. There is nothing in Gutterson to motivate one skilled in the art to modify by adding this additional active step. There is no suggestion in Gutterson that such a step would be necessary to provide stable exogenic allelism as Applicants teach.

Furthermore, in view of the importance of this step in providing stable exogenic allelism in the offspring and the time and expense involved, Dr. Yesodi declares that it would seem to her that if the prior art was aware of the importance and value of this additional step of selecting out the recombinase gene before the crossing step, one skilled in the art would expect there to be some teaching or at least suggestion in the prior art that such step should be performed.

Finally, Dr. Yesodi performed an extensive literature search in response to the Examiner's concern regarding obviousness in view of Gutterson and did not find even one piece of prior art that recommended or advised selecting for plants devoid of recombinase.

Based on these facts, Dr. Yesodi concluded that Gutterson does not make the method of claim 47, specifically the step (c), obvious to one skilled in the art.

As we emphasized during the interview, the step of claim 47, of selecting progeny devoid of the recombinase gene is an additional step, and is not the same as the step in Gutterson that teaches selfing to obtain homozygosity. Applicants' additional active step of selecting progeny devoid of the recombinase gene requires additional molecular techniques that are typically performed in a laboratory and not in the greenhouse. Without some motivation, one skilled in the art would not modify the Gutterson process to add an additional active step incurring additional time if there were no suggestion for such a need.

In order to make a proper obviousness rejection, there must first be some suggestion or motivation to modify the reference. Second, there must be some reasonable expectation of success in the prior art and "not based on applicant's disclosure." And finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991). As Gutterson fails to teach or suggest all of the steps of the presently claimed invention and further fails to provide any

suggestion or motivation to modify the method disclosed in Gutterson in the way suggested by the Examiner, Gutterson cannot make obvious the presently claimed invention.

Based on the three 132 declarations by those skilled in the art supporting the nonobviousness of the selection step and the fact that Gutterson does not teach or even suggest that this additional step should be done in order to get stable exogenic allelism, Applicants respectfully request that this rejection be withdrawn.

In view of the foregoing, it is believed that the entire application is now in condition for allowance, early notice of which would be appreciated. Should any issues remain, Applicants request that the Examiner telephone their representative Rodney Fuller at (202) 371-5838 to discuss the any outstanding concerns that the Examiner may have in order to expedite the allowance of all the claims in this application.

Respectfully submitted,

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Date

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